IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	10/646,536	Confirmation No.: 9859
Applicant	:	Yuh-Shen Song	
Filed	:	August 21, 2003	
TC/A.U.	:	3624	
Examiner	:	Lalita M. Hamilton	
Docket No.:	:	7443-102XX/10310539	
Customer No.:	:	000167	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

December 18, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

This is in response to the Final Office Action dated 16 August 2006.

A formal Notice of Appeal and the required fees are being filed concurrently herewith.

Applicants respectfully traverse the rejection of claims 1 and 2 (as well as 7-8, 16-17, 22-23, 27-41 & 45, which are all dependent from claim 1, with at least claims 7-8, 11, 16 & 17 being also dependent from claim 2), as being anticipated by or obvious from Hoshino (US2002/0111918).

As to claim 1, assuming that the examiner is reading the recited "payer" on the customer possessing Hoshino's customer IC card and is reading the recited "payee" on the store in which Hoshino's electronic wallet transaction apparatus 1,4,5 is located (see also p2 , [0071[-[0075]), **there is no teaching or disclosure in Hoshino of any "financial institution", let alone of a specific account at that institution for the payer**. Indeed, one of Hoshino's stated objectives is to "provide services with high secrecy and security" (p 9, [0137]) and states at p6, [0089] that his invention "can be implemented without configuring a large-scale on-line network". Thus, rather than using networks to attach to remote accounts at remote institutions to thereby provide a remote payment system capable of conducting remote transactions, Hoshino actually teaches a self-contained system that requires no such institutions or accounts, and thus lacks even a suggestion of **"opening a remote payment system account for the payer"** or that **"the payer logs into the remote payment system to conduct a remote transaction"**, as expressly recited in claim 1. Also note that Hoshino states (p1, [001]) that "electronic wallet transaction is carried **out on the spot** in real time", which is a clear teaching away from the quoted language in applicants' claim 1.

No detail is provided as to the nature of Hoshino's "connection apparatus 7", other than it "transfers electronic currency *** stored in the customer IC card 2 to a third party customer IC card 8, and vice versa" (p6, [0090]). As shown in Hoshino's drawings, "connection apparatus 7" appears to be a stand alone transaction device which can be mechanically and electrically directly connected to customer IC card 2 and to third party customer IC card 8. In any event, even if IC card 8 is considered the payee and IC card 2 the payer (or vice versa), there is no suggestion that the payer should **"enter the payee's name, identification information, and transaction amount"**, or that the

payee should **"insert a machine-readable official identification card and enter the assigned transaction identification number"**, as expressly recited in claim 1.

Moreover, **there is no express teaching that any of Hoshino's disclosed apparatus can "issue a cash payment" as expressly required by the last step of claim 1**, and Hoshino's reference to "electronic currency" would appear to be a teaching away from the use of "cash" as a payment instrument. Indeed, Hoshino states at p2, [0004] that **"an electronic means substitutes for a traditional procedure of payment to the opposite party by handing over cash out of a wallet"**.

Furthermore, **as to claim 2**, there is nothing to suggest that the holder of Hoshino's "customer IC card 2" should **"submit a machine-readable official identification card prior to the opening of said remote payment system account"** or that the remote payment system account will be opened **"only if embedded identification information read from the payer's identification card matches the account holder information of the financial account identified by the payer"**.

Indeed with respect to both claims 1 and 2, **there is absolutely no suggestion of any "official identification card" anywhere in Hoshino**. To the contrary, the only means provided for verifying the identity of any person using Hoshino's disclosed IC cards 2,3,8 is "personal identification number (PIN) 47" stored in the IC card's nonvolatile RAM (see paragraphs [0003], [0142] [0149], [0174], [0235], [0237], [0262], [0278], and [0318]). Moreover, even assuming arguendo that Reece (US 2003/0150915) does provide an enabling disclosure (which Applicants respectfully dispute) of a "government-issued identification card" that is included within an otherwise conventional IC card, it is clear that **neither Reece nor Hoshino in view of Reece disclose any mechanism for effecting a "cash payment" from "a payer's account at the financial institution" to a "payee" at "a remote payment system terminal"**.

With respect to dependent claim 26 and 35, despite the examiner's unsupported assertion to the contrary, there is not even a hint in either reference of any "escrow

agent" (claim 26) capability in the remote payment system which "secures the the payment funds *** before issuing the transaction identification number" (claim 35).

It is noted for the record that the examiner's multiple references to "p.2, 3 to p.3, 33 and 36-37" of the Hoshino reference are unclear. In particular, "p.2, 3" appears to be shorthand for paragraph 3 on page 2. However, Paragraph [0003] is on page 1 (not page 2) and Page 2 includes only paragraphs [0014] through [0028] (not paragraph [0003]).

The Commissioner is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-0337, under Order No. 7443-102XX/10310539.

Respectfully submitted,

/John M May #26200/
John M. May
Registration No. 26,200
Attorney for Applicant(s)

FULBRIGHT & JAWORSKI L.L.P.
555 South Flower Street, 41st Floor
Los Angeles, California 90071
Tel. (213) 892-9315
Fax (213) 892-9494